



Patent
Attorney's Docket No. 029430-454

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
Misako MIZUNO et al.) Group Art Unit: 1638
Application No.: 09/577,657) Examiner: A. Kubelik
Filing Date: May 25, 2000)
For: GENE ENCODING CAFFEINE)
SYNTHESIS SYSTEM ASSOCIATED)
ENZYME AND USE THEREOF)

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RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In complete response to the Restriction Requirement set forth in the Official Action mailed on July 23, 2001 (Paper No. 11), Applicants hereby elect with traverse the claims of Group I (Claims 1-7, 11-14 and 16-23), which are drawn to the nucleic acid of SEQ ID NO:2, plants transformed with the nucleic acid, and methods of modifying and producing a plant secondary metabolite.

M.P.E.P. § 803 states that an application may be properly restricted to one or more claimed inventions only if (1) the inventions are independent or distinct as claimed, and (2) there is a serious burden on the Examiner if the restriction is not required. Thus, even if

appropriate reasons exist for requiring restriction, such a restriction should not be made unless there is an undue burden on the Examiner to examine all of the claims in a single application.

Although the Examiner has alleged different classifications for the inventions of Group I (Claims 1-7, 11-14 and 16-23), Group II (Claims 8-10 and 15) and Group III (Claims 24-25), it would seem that a search and examination involving the three claim groups would substantially overlap. For example, the elected invention of Group I is related to the nucleic acid of SEQ ID NO:2, which encodes N-methyl transferase, plants transformed with that nucleic acid and methods of modifying a composition of a plant secondary metabolite and producing a plant secondary metabolite. The non-elected invention of Group II is drawn to microorganisms transformed with nucleic acid of the invention and a method of producing an enzyme (i.e., N-methyl transferase) encoded by the nucleic acid of the invention. The non-elected invention of Group III is drawn to an N-methyl transferase of SEQ ID NO:1. As overlapping subject matter between the elected and the non-elected inventions exists, so too exists an apparent overlap in search and examination. Accordingly, a serious burden would not be imposed on the Examiner to examine all the claims of Groups I, II and III in a single application. Thus, the restriction is improper and should appropriately be withdrawn.

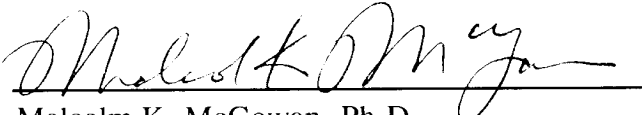
Accordingly, for at least all of the reasons set forth above, withdrawal of the requirement for restriction is believed to be in order. Early and favorable consideration of all the claims of record on the merits is respectfully requested.

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In the event that there are any questions relating to this paper, or the application in general, it would be appreciated if the Examiner would telephone the undersigned attorney concerning such questions so that prosecution of this application may be expedited.

Respectfully submitted,

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